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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

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Appellant(s): Jenkins

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Group 3700**

Charles R. Rust
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed May 10, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is no longer correct.

Upon further consideration, all of the rejections have been withdrawn by the Examiner except the rejection of claim 1 under 35 USC 102(b) as being anticipated by Carll, pn 2,313,801.

Therefore, claim 1 stands rejected under 35 USC 102(b) as being anticipated by Carll. Claims 2 and 3 are allowable over the prior art of record.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. In summary, no amendments were submitted after the Final rejection.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is no longer correct. Upon further consideration, all of the rejections have been withdrawn by the Examiner except the rejection of claim 1 under 35 USC 102(b) as being anticipated by Carll, pn 2,313,801.

Therefore, the only remaining issue is whether claim 1 is anticipated by Carll, pn 2,313,801.

Upon careful reconsideration, the Examiner acknowledges that the prior art of record does not teach or fairly suggest the combination of elements set forth in claims 2 and 3 including a cavity formed in the central portion of the top board, and a plurality of adjustment

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members extending through vertical holes in the top board and being connected to the base member, wherein the adjustment members have a smaller diameter than said given dimension of the vertical holes permitting movement of said blister die cutting unit relative to said base member through a range of 360 degrees (it is noted that this claimed range of movement does not include 360 degrees of rotation, but rather only relatively small adjustment-type movements due to the "play" between the adjustment members and the vertical holes).

(7) *Grouping of Claims*

There is only one claim on appeal.

(8) *Claims Appealed*

The copy of appealed claim 1 contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

2,313,801

Carll

3-1943

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

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35 USC 102(b):

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Carll, pn 2,313,801.

Carll discloses a cutter apparatus with every structural limitation of the claimed invention including:

a base member (e.g., 12),

at least first and second die cutter units (e.g., 14) supported by the base member, each die cutting unit comprising

a support member (e.g., 16) carrying a steel rule die (e.g., 18),

a lost motion connection (e.g., 32 and one of at least 38, 40 or 44) connecting the support member (16) to the base member (12) permitting relative lateral movement of each die cutter unit relative to the base member and relative to each other through a range of 360 degrees.

(11) Response to Argument

First, it is noted that the only remaining issue is the rejection of claim 1 under 35 USC 102(b) as being anticipated by Carll. All arguments directed to the other issues are deemed moot due to the withdrawal of the other rejections as described above.

Next, the Examiner maintains that Carll discloses every structural limitation of the claimed invention and that the rejection should be sustained. As is clearly seen from the rejection as described above, Carll discloses every claimed element of claim 1. The only difference between the invention of Carll as disclosed and the claimed invention is how the

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inventions are intended to be used. On page 6 of the Brief, appellant seems to imply that there is a patentable distinction between the claimed invention and that of Carll wherein appellant states:

“In neither of these disclosures is there permitted any movement between the base 12 of Carll and each of his individual die members 14. As Carll points in his specification at page 2, column 2, line 39:

In operation, each individual die member 14 is accurately adjusted to register with its respective label and the bolts 32 tightened to maintain the blocks in their adjusted position.

As noted from a review of applicant's disclosure and claims the invention of applicant is totally different and distinct from Carll in that applicant's die members are free to move relative to the base.”

The Examiner respectfully submits that Appellant's argument is not understood. It is not at all clear how the claimed invention is totally different, or in any way patentably distinct, from the invention of Carll. Carll discloses a lost motion connection (although not named as such) which is the same structure as that of the claimed invention. On page 6, line 14 of the original specification of the present application, the lost motion connection is defined as follows:

“the member 70 of a smaller diameter than holes 72 amounts to a lost motion connection connecting the support member to the base 31.”

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Carll discloses such structure. Specifically, Carll discloses a threaded member 32 which corresponds to one of the members 70 of the present invention, and a vertical hole 38 (or even 40 or 44) which corresponds to one of the holes 72 of the present invention, wherein the threaded member 32 is substantially smaller than the hole 38 to permit movement therebetween including lateral movement relative to each other through a range of 360 degrees.

As previously stated, the only difference between the two inventions is how they are intended to be used. Carll discloses that the die cutting units are locked in position during use, while the die cutting units of the present invention are free to move during use. However, there is no structural difference between the claimed invention and the invention of Carll, thus the difference amounts to a functional recitation of intended use, and as is well established in patent law, a functional recitation of intended use cannot serve to distinguish a claimed apparatus/device over the prior art. Further, it is noted that there is nothing in Carll which prevents it from being used in the manner described by appellant. For example, by simply not tightening the screws 32, Carll is exactly the same as the claimed invention. No modification of the structure disclosed by Carll is required. This loosened state is clearly present in Carll during adjustments, but also could be present during use of the device if a user chose to do so. Also, it is noted that there is nothing preventing the adjustment members of the present invention from being tightened down to lock the die cutting units in place and thus used in the same manner as the die cutting units of Carll. A structural difference between the lost motion connection of the claimed invention and the corresponding structure of Carll cannot be found.

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Therefore, a structural difference between the claimed invention and the invention of Carll cannot be found.

Regarding appellant's argument in the third paragraph on page 8 of the Brief, the Examiner respectfully disagrees with appellant's position that "[T]he reference of Carll does not in spirit anticipate the claimed invention." The Examiner's position is that Carll does anticipate the claimed invention in that Carll discloses all of the claimed structure set forth by each and every claimed limitation, and the Examiner has provided a showing on an element-by-element basis of the claimed elements and their corresponding structure in Carll in the rejection above.

In the fourth paragraph on page 8 of the Brief, appellant argues that Carll teaches fixing each of the die members 14 to the base 12 and thus does not provide the free movement of applicant's invention. Again, the Examiner's position is that the structure of Carll is exactly the same as the structure of the claimed invention. The only difference is whether the adjustment members are tightened to lock the die cutting units in place. Such a difference amounts to an intended use of the structure disclosed by Carll and such an intended use of a device/apparatus cannot serve to patentably distinguish a claimed invention over the prior art. While it may be arguable that an intended use can imply structural limitations of the claimed invention and in that way distinguish a device/apparatus over the prior art, no such structural difference can be found between the presently claimed invention and the invention of Carll.

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In the paragraph bridging pages 8 and 9 of the Brief, appellant argues that the lost motion connection cannot be found in Carll. The Examiner respectfully and emphatically disagrees, and the elements corresponding to the lost motion connection have been described above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner
Art Unit 3724

cf
July 29, 2002

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